

REMARKS

The Examiner has indicated that the reply filed on 3/18/08 is not fully responsive to the prior Office Action, stating that the Applicant should amend or provide claims that are “directed to an outer air seal assembly and not to an engine turbine section.” The Applicant respectfully submits that the Examiner’s response does not establish a prima facie case necessary to meet the burden established for making the proposed restriction; the Examiner’s response is improper and the Applicant hereby requests withdrawal thereof.

As an initial matter, the Applicant notes that the Examiner provides no statutory basis for his response, except for a broad reference to the general requirements of 37 CFR 1.111. In the interest of moving the case forward, the Applicant suggests that guidance related to the Examiner’s request is found in MPEP §821.03, which provides in relevant part:

1) “[c]laims added by amendment following action by the examiner ... to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.” and 2) [when providing a reply,] the action should include form paragraph 8.04.

For purposes of clarity, the Applicant notes that 37 CFR 1.145 states:

[i]f, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144 (emphasis added);

while MPEP form paragraph 8.04 provides the following:

[n]ewly submitted claim [1] directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: [2] (emphasis added)

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [3] withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

If the Examiner considers the invention now claimed to be distinct from and independent of the invention previously claimed, the Applicant respectfully requests that the Examiner issue a proper restriction requirement, subject to the provisions of §§ 1.143 and 1.144, including the specific reasons (as directed by MPEP §821.03 in form paragraph 8.04, section [2]) for his assertion. Particular clarification is also requested regarding the Examiner's description of the invention now claimed in which "lines 12 – 13 positively claim the blade", as the Applicant does not see such a reference on line 12 or 13.

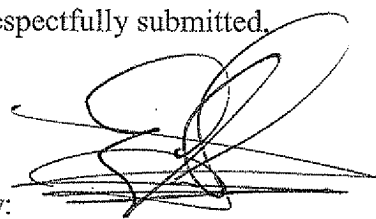
Conclusion:

Applicants respectfully request allowance of the present application in view of the foregoing arguments. The Commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Dated: _____

8/25/08

Respectfully submitted,



By: _____

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